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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,581	06/24/2003	Gary Balakoff	44904.000736	8202

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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,581

Applicant(s)

BALAKOFF ET AL.

Examiner

Christopher P. Bruenjes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 3, 2006 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 16, the limitation "further comprises a percentage by weight in the range of said 30% to about 85%"

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renders the claim vague and indefinite because it is not understood to what the percentage by weight is referring. Furthermore, the limitations "with said percentage by weight selected to a desired level of adhesion" renders the claim vague and indefinite because it is not understood what weight provides a "desired level of adhesion" or whether this is a different or more specific percentage by weight than the claimed 30% to 85%.

Regarding claim 17, the limitation "provided at a varying ratio" renders the claim vague and indefinite because it is not understood how the flexible polyolefin is provided at a varying ratio. Does this mean that the flexible polyolefin has different ratio in different locations within the film? Or, is this limitation a process limitation in which the flexible polyolefin is not added only at once but rather in stages of varying ratios? Or, does this limitation merely mean that the flexible polyolefin is added in different ratios in different embodiments? Note that the later interpretation of the limitation would provide that any ratio of flexible polyolefin in the film would read on claim 17.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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5. Claims 1-4 and 6-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gotoh et al (USPN 5,286,781) in view of Harvie et al (USPN 5,693,405). Note claims 1-4 and 6-15 were rejected over this combination of references previously, however, the rejection will be rewritten below for clarification in light of the newly added claims 16 and 17.

Regarding claims 1-4 and 6-9 and 11, Gotoh et al teach a masking or surface protective film (col.1, 1.20-23) comprising a first side and second side. The limitations in the claim that the first side "is not an adhesive coating, and does not have an adhesive coating applied thereto" is interpreted in the broadest reasonable interpretation to limit the first side to not be an adhesive coating, yet can be an adhesive film and still read on the claim. In Applicant's specification page 7 paragraph 24, the Applicant specifically defines film and specifically differentiates coated films and co-extruded films. In this case the first side is a smooth surface film formed by co-extrusion and does not have an additional adhesive coating added to it. Therefore, Gotoh et al anticipate a smooth adhesive surface film that is not an adhesive coating as it is defined in Applicant's specification. The first side comprises hydrogenated styrene-isoprene-styrene block copolymer, which is styrene-

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ethylene/propylene-styrene, or hydrogenated styrene-butadiene-styrene, which is styrene-ethylene/butylene-styrene, or hydrogenated styrene-isoprene, which is styrene-ethylene/propylene, or hydrogenated styrene-butadiene, which is styrene-ethylene/butylene (col.3, 1.51-60). The first side further comprises 10-200 parts by weight per 100 parts by weight of the block copolymer of tackifying resin (col.4, 1.8-10) and 25-200 parts by weight per 100 parts by weight of the block copolymer of flexible polyolefins (col.4, 1.40-42). The flexible polyolefins are ethylene, polypropylene, or acrylate-modified polyethylenes (col.4, 1.17-24). The masking film comprises at least two co-extruded layers (col.5, 1.37-41).

Gotoh et al fail to explicitly teach forming the second side with a rough surface. However, Harvie et al teach the second side of a masking or surface protective film is matte embossed so that the film does not block on a roll or wrinkle during winding. The patterned embossed side of the film traps a quantity of air between wound layers of film as the film is being wound onto the roll. This air entrapment also facilitates the wrinkle-free unwinding of the film from the roll as it is being applied to a substrate (col.2, 1.24-30). Unembossed portions are applied to the second side to form a pattern decoration in order to provide brand identification and/or

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written marketing, instructional or advertising material without the need of time consuming and expensive printing techniques (col.1, 1.55-64). One of ordinary skill in the art would have recognized that the second side of a masking or surface protective film is matte embossed in a pattern with embossed and unembossed areas, so that the film does not block on a roll or wrinkle during winding and in order to provide brand identification and/or written marketing, instructional or advertising material without the need of expensive and time consuming printing processes, as taught by Harvie et al.

Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to matte emboss the second side of the masking film of Gotoh et al, so that the film does not block on a roll or wrinkle during winding, the matte embossment is formed in a pattern of embossed and unembossed areas in order to provide brand identification and/or written marketing, instructional or advertising material without the need of expensive and time consuming printing processes, and one or more of the layers of the film include a pigment in order to improve visualization of the pattern, as taught by Harvie et al.

Regarding claim 10, Harvie teaches that one or more layers of the film include a pigment such that the matte portions

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appear different than the glossy unembossed portions, in order for ready visualization of the pattern (col.7, 1.3-12).

Regarding claims 12-13, because the first side of Gotoh et al is formed from the same composition as the claimed invention and made by the same co-extrusion process and the properties of the same composition must be the same, the first side of Gotoh et al is inherently capable of removably adhering to a textured surface having a surface roughness in the range of from about 150 to 1000 Ra such as the surfaces claimed in claims 12 and 13.

Regarding claims 14 and 15, Gotoh et al teach specific examples of the proportions of the three components are shown in examples 3-5 with the hydrogenated SIS or SBS forming between 42% and 56% of the layer, and the tackifying resin forming between 28% and 43% of the layer (col.7, 1.45 - col.8, 1.18).

Regarding claim 16, Gotoh et al teach that at least one thermoplastic elastomer having saturated rubber mid-blocks is present in the smooth surface of the first side in an amount within the claimed range of 30 to 85%. Note the limitation "said percentage by weight selected according to a desired level of adhesion" given its broadest reasonable interpretation would include any percentage by weight within the claimed range of 30 to 85%.

Regarding claim 17, Gotoh et al teach that a flexible polyolefin is provided in the smooth surface of the first side as a secondary component. Note the limitation "at a varying ratio" given its broadest reasonable interpretation would include any amount of flexible polyolefin.

6. The 35 U.S.C. 103 rejection of claim 5 over Gotoh in view of Harvie and Okumura is repeated for the reasons set forth in the previous Office Action mailed December 14, 2004, Pages 6-7 Paragraph 3.

ANSWERS TO APPLICANT'S ARGUMENTS

7. Applicant's arguments regarding the 35 U.S.C. 103 rejections of claims 1-4 and 6-15 over Gotoh in view of Harvie have been fully considered but they are not found persuasive.

In response to Applicant's argument that there is no motivation or suggestion to combine Gotoh and Harvie since Harvie is directed only to adhering to surfaces with a surface roughness less than 150 Ra. The reason Harvie is unable to adhere to rough surfaces is because the smooth side of Harvie is not adhesive. However, the adhering side of the claimed invention and Gotoh are adhesive. The adhering surface of Gotoh is not dependent on the roughness of the opposing surface of the

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film since the adhering surface of Gotoh is adhesive. There is no teaching or suggestion to one having ordinary skill in the art that Gotoh would not be able to adhere to a rough surface if the opposite surface of the film was roughened or matted. One of ordinary skill in the art would not believe that adding the matted surface of Harvie would destroy the ability of Gotoh to adhere because the adherence of Gotoh to rough surfaces is provided by the chemical adhesiveness of the adhering layer is not dependent on the opposite surface of the film.

In response to Applicant's argument that Gotoh fails to provide a suggestion to one of ordinary skill in the art that printing or indicia would be added to the film, Harvie teaches that it is well known in the art to print various information or designs used for identification, instructions, and/or decorations. Therefore, it would have been obvious to one having ordinary skill in the art that a masking film such as Gotoh would have printing applied to it in order to provide identification, instructions, and/or decorations, as taught by Harvie.

In response to Applicant's argument that there is no evidence, teaching, nor suggestion that printing is more costly and troubling than the applying indicia in the manner in which Harvie does, Harvie specifically teaches that the method of

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applying indicia to the masking film taught in Harvie is less expensive and less troubling than printing (col.1, 1.42-57).

In response to applicant's argument that applicant applies the rough surface for other reasons and not for the purpose of adding printing, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

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8. Applicant's arguments regarding the 35 U.S.C. 103 rejection of claim 5 over Gotoh in view of Harvie and Okumura have been fully considered but they are not found persuasive.

In response to Applicant's argument that claim 5 is allowable for the same reasons as claim 1, see the response to the arguments regarding claim 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB *CPB*
February 24, 2006

[Signature]
HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

2/26/06